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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,929	09/05/2000	Ryota Akiyama	1046.1100RE	7584

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,929

Applicant(s)

AKIYAMA ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 9/28/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/510,122.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination

1. The request filed on 26 September 2002 for an RCE based on parent Application No. 09/654,929 is acceptable and a RCE has been established. An action on the RCE follows.

Drawings

2. The drawing changes to Figure 2, submitted 8 June 2001 and Figure 7, submitted 28 August 2002 are approved.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Reissue Applications

4. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

a. It does not state whether the inventor is a sole or joint inventor of the invention claimed.

b. The nature of the defect(s) in the declaration is that the error set forth as the basis for the Reissue application is based on improper recapture. Specifically, the "input switchover" and "output switchover", argued as the error which forms the basis for the reissue application, were added to the original claims and argued by applicant as the distinguishing features of the claims in both amendments B, filed 6 May 1997, and C, filed 8 December 1997, of the parent application. Therefore, correction constitutes improper recapture and cannot form the basis of a reissue application.

6. Claims 1-22 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. The rejection of Claims 8-22 under 35 U.S.C. 112, first paragraph is withdrawn.

9. The addition of the one way connection language (removal of a 2 way communication) is not seen to be patentably distinguish the claims over the prior art because removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963), therefore, the previous rejections stand.

Claim Rejections - 35 USC § 103

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-10, 12-14, 16-18, 20, 21, 22 are rejected under 35 U.S.C. 103(a) as being anticipated by Shear (5,510,498).

As per Claim 8.

Shear ('598) discloses:

a digital information receiving means, see figure 3 (304);
drive means for reading digital information from and writing digital information to a removable storage medium, see (308) and Column 13, lines 30-54;
information converting means for converting digital information received into at least one of visible or audible data, see (316) and Column 20, lines 31-40;
switch means for switching a connection between said digital information receiving means and said information converting means, between said digital information receiving means and said drive means, and between said drive means and said information converting means, see (308) and column 16, line 54 – column 17, line 12.

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken that removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F.2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 9.

Shear ('598) further discloses:

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a deciphering means for deciphering digital information received by receiving means when information is ciphered and for providing the deciphered digital information to said information converting means, see figure 3 (310, 316),

and for deciphering digital information read by said drive means when the information is ciphered and for providing the deciphered information to said information converting means, see (308, 310, 316).

As per Claim 10.

Shear ('598) further discloses billing managing means for managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

As per Claim 12.

Shear ('598) discloses:

a digital information receiver, see figure 3 (304);

a drive device reading digital information from and writing digital information to a removable storage medium, see (308) and Column 13, lines 30-54;

a converter converting digital information received into at least one of visible or audible data, see (316) and Column 20, lines 31-40;

a switch means for switching a connection between said digital information receiver and said information converter, between said digital information receiver and said drive device, and between said drive device and said information converter, see (308) and column 16, line 54 – column 17, line 12.

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken thatn removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 13.

Shear ('598) further discloses:

a decipherer device deciphering digital information received by receiving means when information is ciphered and for providing the deciphered digital information to said information converting means, see figure 3 (310, 316),

and for deciphering digital information read by said drive means when the information is ciphered and for providing the deciphered information to said information converting means, see (308, 310, 316).

As per Claim 14.

Shear ('598) further discloses billing managing device managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

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As per Claim 16.

Shear ('598) discloses:

- a communication path, see Figure 3 (connector to host computer)
- a storage medium storing digital data, see figure 1 (100);
- a converter converting digital information received into at least one of visible or audible data, see figure 3 (316) and Column 20, lines 31-40;
- a switch having
 - a first switch position which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316) and column 16, line 54 – column 17, line 12;
 - a second switch position which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316) and column 16, line 54 – column 17, line 12, and
 - a third switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken that removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F.2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 17.

Shear ('598) further discloses:

- a deciphering device which
 - deciphers digital information received by receiver when information is ciphered and for providing the deciphered digital information to said information converter, see figure 3 (310, 316),
 - and deciphers digital information read by said drive when the information is ciphered and for providing the deciphered information to said information converter, see (308, 310, 316).

As per Claim 18.

Shear ('598) further discloses billing managing device managing billing, see figure 1 (300) based on utilization of digital information received and read, see column 9, lines 26-46.

As per Claim 20.

Shear ('598) discloses:

- a communication path, see Figure 3 (connector to host computer)
- a storage medium storing digital data, see figure 1 (100);

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a converter converting digital information received into at least one of visible or audible data, see figure 3 (316) and Column 20, lines 31-40;

a switch having

a first switch position which, when non encrypted data is provided, connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12;

a second switch position which, when encrypted digital data is provided, connects digital information provided to the converter and the decoder and then the digital data is decoded by the decoder and converted by the converter into at least visible or audible data, see figure 3 (310, 316) and column 16, line 54 – column 17, line12;

a third switch position which, non encrypted digital data is read from the storage medium connects converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12, and

a fourth switch position which, when encrypted digital data is read from the storage medium, when encrypted digital data is provided, connects digital information provided from the storage medium to the converter and the decoder and then the digital data is decoded by the decoder and converted by the converter into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 310, 316) and column 16, line 54 – column 17, line12;

a fifth switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57. Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken thatn removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 21.

Shear ('598) discloses:

a first switch position which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12;

a second switch position which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12; and

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a third switch position which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken thatn removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 22.

Shear ('598) discloses:

a first means which connects digital data provided by the communication path to the converter so that the converter converts the digital data into at least visible or audible data, see figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12;

a second means which connects digital data read from the storage medium to the converter so that the converter converts the digital data read from the storage medium into at least visible or audible data, see figure 1 (100), figure 3 (304, 308, 316) and column 16, line 54 – column 17, line12; and

a third means which connects digital data provided by the communication path to the storage media so that the digital data provided via the communication path is stored in the storage medium, see Column 9, lines 47-57.

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken thatn removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

As per Claim 23.

Shear ('598) discloses:

a digital information receiving means, see figure 3 (304);

drive means for reading digital information from and writing digital information to a removable storage medium, see (308) and Column 13, lines 30-54;

information converting means for converting digital information received into at least one of visible or audible data, see (316) and Column 20, lines 31-40;

switch means for switching a connection between said digital information receiving means and said information converting means, between said digital information receiving means and said drive means, and between said drive means and said information converting means, see (308) and column 16, line 54 – column 17, line12;

selecting means for selecting one of said digital information received by said digital information receiving means and said digital information read by said drive means and inputting the selected digital information to said information converting

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means to obtain at least one of visible and audible data based on the selected digital information which is received from different types of digital information sources, see figure 6 (906).

Shear ('598) does not specifically disclose the communication is one-way.

Official Notice is taken thatn removal of features is an obvious variation, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use a one-way communication as an obvious variation of Shear ('598) for the benefit of hardware cost savings.

12. Claims 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (5,410,598) in view of Allen (5,418,713).

As per Claim 11.

Shear ('598) does not specifically disclose extension means for extending digital information received by said digital information receiving means when said digital information is compressed,

and for extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

As per Claim 15.

Shear ('598) does not specifically disclose extender extending digital information received by said digital information receiving means when said digital information is compressed,

and extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches data compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

As per Claim 19.

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Shear ('598) does not specifically disclose extender extending digital information received by said digital information receiving means when said digital information is compressed,

and extending said digital information read by said drive means when said digital information is compressed.

Allen ('713) teaches data compression, see figure 2 (7) and decompression, see figure 6 (169), for the storage and exchange of digital video/graphic data files for the benefit of faster transfer times.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Shear ('498) to include compression and decompression of digital information as taught by Allen ('713) for the benefit of faster transfer times.

Allowable Subject Matter

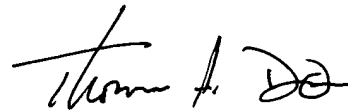
13. Claims 1-7 are allowable, Arnold et al (4,558,176) in view of Hartman Jr (5,224,166) does not disclose a "signal processor", "error processing means", "a first and second input switchover" and "output route switchover for receiving encrypted and non-encrypted data" as claimed, but remain rejected to under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'Thomas A. Dixon', with a stylized flourish at the end.

Thomas A. Dixon
Examiner
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October 23, 2002